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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,792	01/23/2001	Craig A. Lewis	07703-327001 / WCR0117	2248

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EXAMINER	
CHAMPAGNE, DONALD	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/767,792	LEWIS ET AL.	
	Examiner	Art Unit	
	Donald L. Champagne	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 October 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-17,19-25,27-40 and 42-72* is/are pending in the application.

4a) Of the above claim(s) *49-70* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-17,19-25,27-40,42-48,71 and 72* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 January 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 13 September 2005 has been entered.

Claim Rejections - 35 USC § 102 and 35 USC § 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1, 3, 5, 7-17, 21, 25, 28, 30-40, 44 and 71 are rejected under 35 U.S.C. 102(e) as being anticipated by Nicholson (US006332128B1), hereafter Nicholson (2001).

5. Nicholson (2001) teaches (independent claims 1 and 25) a method and article comprising a computer-readable medium for providing discounts for items in an automatic transaction machine, the method comprising: validating cash or a card (to purchase items at *HVR POS terminal **11***, col. 5 lines 21-24) and validating a separate discount means provided by a user

(*frequent shopper card* or *magnetic medium such as a prepaid card*, col. 4 lines 40-60) at *gasoline station* ***12***, which, with *HVR POS terminal* ***11***, comprises the automatic transaction machine (para. 6-8 below), wherein the discount means has an associated discount value (*discount credits*, col. 3 line 57, and *total PPU discount*, col. 5 lines 24-26) that is processed as a phantom coin signal (para. 9 below); detecting a selection of an item or a group of items (*gasoline*), each having a preset vending price (*the normal price*), and discounting the vending/*normal* price of the item or a group of items according to the discount value (col. 6 lines 29-31).

6. Interpretation of "automatic transaction machine" Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...".

7. The instant application contains no such clear definition for the phrase "automatic transaction machine". The phrase is supported by various embodiments, but these are examples, and do not meet the requirements for a "clear definition." Hence, the examiner is required to give the term its broadest reasonable interpretation, which the examiner judges to be any mechanized transaction system. The mechanized transaction system taught by Nicholson (2001) reads on an "automatic transaction machine".

8. This interpretation is based first on the broadest applicable definition of "automatic", which is *done or produced as if by machine; mechanical* (Merriam-Webster's Collegiate Dictionary). Hence any machine is "automatic". The examiner also considered the definition of the common "ATM", where the "automated" refers to replacing the function of the teller (Merriam-Webster's Collegiate Dictionary). The reference invention also teaches automatic steps explicitly (e.g., col. 7 lines 5-8 and 58-59).

9. Interpretation of "phantom coin signal". Para. [0026], [0047] and [0048] of the published application (US 20020099604A1) disclose that a "phantom coin signal" is "the equivalent to coin signals" generated by a discount means. The reference teaches that the discount means generates a signal expressed in cash terms, which reads on a phantom coin signal.

10. Applicant argues (pp. 14-16 of 17) for a narrower definition of phantom coin signal. The argument is not compelling for the reasons cited in para. 9 above. In particular, published application para. [0048], which applicant quotes at the top of p. 15 of 17, discloses the following (emphasis added): "Thus, the appropriate software to generate the phantom coin signals could be resident in only the coin validator (for tokens) or the bill validator (for coupons) or in another discount device." There is no disclosure that the phantom coin signal must be generated by the coin device. First, the claims are limited to a "discount means". Except for claim 72, there is no limitation to said means being a "token". Furthermore, the quoted sentence presumes that a "token" is coin-like. But the prior art, a second Nicholson reference (Nicholson 2004) quoted in para. 18 below, teaches a token that is coupon-like. Since the instant application does not contain a "clear definition" of "token", the broader meaning used by Nicholson (2004) must prevail if and when "token" is claimed.

11. Nicholson (2001) also teaches at the citations given above claims 3, 15, 16, 21, 39, 44 and 71.

12. Nicholson (2001) also teaches: claims 5, 7, 8, 12, 28, 30, 31 and 35 (col. 7 lines 36-38); claims 9-11, 13, 14, 32-34, 36 and 37 (col. 3 line 67 to col. 4 line 34); and claims 17 and 40 (col. 7 lines 22-32).

13. Claims 4, 6, 19, 20, 22-24, 27, 29, 42, 43 and 45-48 are rejected under 35 U.S.C. 103(a) as being obvious over Nicholson (2001).

14. Nicholson (2001) does not teach (claims 4, 6, 27 and 29) not returning the discount means (frequent shopper card) and returning the discount value in cash. The former would have been obvious to one of ordinary skill in the art, at the time of the invention, if the means/card was reported lost or stolen. Giving the discount value as cash would have been obvious when the system was not functioning and the customer had to seek product at another establishment.

15. Nicholson (2001) does not teach (claims 19 and 42) calculating the discount value as a fraction of the vending price. Because some customers can be expected to want to see their discount as a percentage savings, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add calculating the discount value as a fraction (percentage) of the vending price to the teachings of Nicholson (2001).

16. Nicholson (2001) does not teach (claims 20 and 43) that the loyalty card/discount means contains the discount value. Because it would permit transfer of customer data between stores without a network, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Nicholson (2001) that the loyalty card/discount means contains the discount value.

17. Nicholson (2001) does not teach (claims 22-24 and 45-48) recording the number of customer visits and paying a bonus on that basis. Because these features would enhance the customer loyalty program taught by Nicholson (2001), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Nicholson (2001) recording the number of customer visits and paying a bonus on that basis.

18. Claim 72 is rejected under 35 U.S.C. 102(b) as being anticipated by Nicholson (US006778967B1, Nicholson 2004). Nicholson (2004) teaches a method for providing discounts for items in an automatic transaction machine, the method comprising: validating cash or a card (by purchasing an item, col. 4 lines 21-23) and validating a separate discount means, comprising a token, provided by a user (col. 5 lines 14-17) at a *gasoline dispenser* (col. 3 line 32), which reads on the automatic transaction machine (para. 6-8 above), wherein the discount means has an associated discount value (col. 4 lines 45-47) that is processed as a phantom coin signal (para. 9-10 above); detecting a selection of an item or a group of items (including *gasoline*), each inherently having a preset vending price; and discounting the vending price of the item (*gasoline*) according to the discount value (col. 5 lines 17-18).

Suggestion of Allowable Subject Matter

19. Applicant can overcome the instant rejections based solely on Nicholson 2001 and Nicholson 2004 by limiting the claims to "a coin-like token".

Conclusion

20. The references made of record and not relied upon are considered pertinent to applicant's disclosure. Jacoves et al. (US006741968B2) and Rademacher (US005450938A) teach some features of the instant invention.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

22. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

24. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

Donald L. Champagne
Primary Examiner
Art Unit 3622

6 January 2006

DONALD L. CHAMPAGNE
PRIMARY EXAMINER